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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,247	11/15/2001	Gary K. Michelson	101.0083-00000	4911
22882	7590	11/04/2004	EXAMINER	
MARTIN & FERRARO, LLP 1557 LAKE O'PINES STREET, NE HARTVILLE, OH 44632			PREBILIC, PAUL B	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 11/04/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/991,247
Filing Date: November 15, 2001
Appellant(s): MICHELSON, GARY K.

Amedeo F. Ferraro
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 4, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The Brief positively states that the claims stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,294,187	Boyce et al	09-2001
5,899,939	Boyce et al	05-1999
5,484,437	Michelson	01-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-16, 18, 23-49, 55-78, and 84-88 are rejected under 35 U.S.C.

103(a) as being unpatentable over Michelson (US 5,860,973) in view of Boyce et al (US 6,294,187). Michelson discloses a body (400) with upper (402) and lower (404) portions and side (406) portions. Michelson also has projections or ratchetings (220, 420) and openings (428) as claimed; see Figure 10, Figure 8, column 8, lines 47-61, column 5, line 57 to column 6, line 5, and column 7, lines 46-59. Michelson lacks a composite of cortical bone and bioresorbable material as claimed but teaches that the implants thereof can be made of a wide variety of materials including hydroxylapatite, hydroxylapatite tricalcium phosphate, osteoconductive material, osteoinductive material, osteogenic material, other fusion enhancing material, and/or titanium; see column 5, line 66 to column 6, line 5. However, Boyce discloses that such materials where known; see column 11, line 65 to column 12, line 9, column 14, lines 33-35 and column 7, line

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55 to column 8, line 39. Therefore, it is the Examiner's position that it would have been considered prima facie obvious to an ordinary artisan to make the Michelson implant out of the cortical bone/bioresorbable material composite of Boyce for the same reasons that Boyce does the same (see column 1, line 56 to column 2, line 4 of Boyce) or as a binder to the hydroxylapatite particles of Michelson (see column 5, line 66 to column 6, line 5 of Michelson and see column 8, lines 41-58 of Boyce),

With regard to claim 8, Michelson fails to disclose the dimensions as set forth in the claim. However, the mere recitation of size or proportion is considered prima facie obvious over the structure set forth in Michelson because there is no clear indication that such size or proportion is for some particular purpose, performs some unexpected function, or has some unobvious characteristics. MPEP 2144.04 states:

In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

With regard to claim 23, Michelson discloses round openings but lacks oval openings as claimed. However, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use oval openings because Applicants have not disclosed that oval openings provides some advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicants' invention to perform equally well with a "generally oval-shaped" opening as compared to a round opening.

Therefore, it would have been an obvious matter of design choice to modify Michelson to obtain the invention as specified in the claims.

With regard to claims 26-28, Michelson discloses one instrument opening in each end but lacks at least one or three openings as claimed. However, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have additional openings because Applicants have not disclosed that additional provides some advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicants' invention to perform equally well because the instruments could be used in a serial fashion instead of at the same time as in the structure. Therefore, it would have been an obvious matter of design choice to modify Michelson to obtain the invention as specified in the claims.

Claims 17, 50, and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michelson and Boyce et al as applied to claims 1-3, 5-16, 18, 23-49,, 55-78, and 84-88 above, and further in view of Boyce et al (US 5,899,939). Michelson fails to disclose the use of a scar-inhibiting material with the implant as claimed. However, Boyce discloses that it was known to coat many types of medically/surgically useful substances onto similar vertebral implants; see column 4, line 53 to column 5, line 32. Therefore it is the Examiner's position that it would have been obvious to coat the Michelson device with any useful substance, including scar-inhibiting materials, since there has been no showing of criticality for using such a substance in the same environment as Michelson.

Claims 19-22, 51-54, and 80-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michelson and Boyce et al as applied to claims 1-3, 5-16, 18, 23-49, 55-78, and 84-88 above, and further in view of Michelson (US 5,484,437). Michelson fails to disclose the use of a drill, mill, or hollow tube instrument with the implant thereof. However, Michelson teaches that it was known to use a hollow insertion tube, drill, and mill with similar spinal implant systems; see Figure 11A and column 21, line 54 to column 22, line 22. Therefore, it is the Examiner's position that it would have been considered prima facie obvious to include a hollow insertion tube, drill and mill to the Michelson device in order to prepare the Michelson ('973) implant for implantation.

(11) Response to Argument

Beginning of the first full paragraph of page 6 in the Brief, Appellant argues that the passage relied upon by the Examiner identifies problems associated with bone grafts and not implants made of materials other than bone. However, the Examiner asserts that both Michelson '973 and Boyce '187 disclose using bone graft material in the form of hydroxylapatite, which is a major component of cortical bone. Therefore, this argument is considered wholly unpersuasive.

Next, Appellant argues that there would be no need to make the implants of Michelson '973 stronger because they are already stronger than either bone grafts or the bone composite of Boyce '187. However, Appellant provides no support for this allegation that the implants of Michelson '973 are stronger than either bone grafts of the bone composite of Boyce. And the Examiner was unable to find support for this contention either. Rather, Michelson discloses a wide variety of materials for making

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the bone graft and does not appear to be limited to any sort of strength regime as alleged.

Finally, Appellant argues that the Examiner has used impermissible hindsight in that Michelson '973 and Boyce "are mutually exclusive" and are uncombinable to an ordinary artisan; see page 7, section (II) of the Brief. In response, the Examiner asserts that Michelson and Boyce are clearly not mutually exclusive because they both disclose using bone graft material (i.e. hydroxylapatite) and because both disclose making their implants from a wide variety of materials in the same art.

For the above reasons, it is believed that the rejections should be sustained.

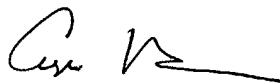
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Respectfully submitted,



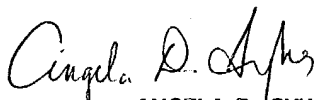
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